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| APPLICATION NO.                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/814,455                             | 03/31/2004  | Ashley Andersen      | 03986- P0001B       | 7381             |
| 24126                                  | 7590        | 11/28/2006           | EXAMINER            |                  |
| ST. ONGE STEWARD JOHNSTON & REENS, LLC |             |                      | FIDEI, DAVID        |                  |
| 986 BEDFORD STREET                     |             |                      |                     |                  |
| STAMFORD, CT 06905-5619                |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3728                |                  |

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/814,455             | ANDERSEN, ASHLEY    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | David T. Fidei         | 3728                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 9-19 and 21-24 is/are allowed.
- 6) Claim(s) 1-6,8 and 25-29 is/are rejected.
- 7) Claim(s) 7 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/04 &amp; 3/10/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 9-19 and 21-24 are allowable. The restriction requirement, as set forth in the Office action mailed on October 2, 2006, is hereby withdrawn.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahler (US Patent no. 5,088,599). A storage medium is disclosed comprising a tray 60 and a cavity defined by jacket 10. Two tray protrusions are defined by the top and bottom of rim 68 as shown in figure 5 with an intermediate layer comprising two cavity protrusions 34 and 38.

As to claims 26 and 27 a paperboard material is contemplated in col.3, line 37 as a cardboard material.

4. Claims 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ravis (US Patent no. 2,866,541). A storage medium is disclosed in the embodiments of 12-15 comprising a tray 82 and a cavity defined by jacket 80. An intermediate member 84 has two protrusions

defined at the channel ends 94, 95 that appears to be substantially the same size as two tray protrusions 85, 86.

As to claims 26 and 27 a paperboard material is contemplated in col.2, line 36 as a cardboard material

5. Claims 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Burtch (US Patent no. 6,290,060). In the embodiments of figures 3-5 there is disclosed a storage medium holding apparatus comprising a storage medium tray holder 40 and a first part 42.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-6, 8, 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey (US Patent no. 6,360,887) in view of Burtch (US Patent no. 6,290,060). Pettey discloses a compact disc holding apparatus where the book cover, e.g., see figure 1, #12, serves as a disc holding medium. The difference between the claimed subject matter and Petty resides in the book cover having a storage holder where the cover is slideable from an open to a closed position to facilitate removal of the storage medium from the holder.

Burtch teaches the construction of disc holder with a storage medium 40 slideably received within a sheath member 42. It would have been obvious to one of ordinary skill in the art to modify the book cover of Pettey by constructing a retaining pocket as taught by Burch in order to form a retaining apparatus to hold a disc the inhibits possible scratching by sliding the holding medium rather than the disc.

As to claim 8, Official Notice is taken for the use of a stem to detachably retain the disc through the center hole. To employ such a retaining means would have been within the level of ordinary skill for the reason of retaining the disc to the support medium 40.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of the "Itsy Bitsy Spider and Other Favorites". It would have been obvious to one of ordinary skill in the art to include a cutout so that the storage medium may be seen there through as taught by the prior art submitted as "Itsy Bitsy Spider and Other Favorites" in order to provide aesthetic appeal and advertising.

***Allowable Subject Matter***

9. Claims 9-19 and 21-24 allowed.

10. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. The examiner can normally be reached on Monday - Thursday 6:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 2724562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David T. Fidei  
Primary Examiner  
Art Unit 3728

Dtf  
November 24, 2006